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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,761

06/13/2006

Bengt Langstrom

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07/12/2010

GE HEALTHCARE, INC.

IP DEPARTMENT 101 CARNEGIE CENTER

PRINCETON, NJ 08540-6231

EXAMINER

SCHLIENTZ, LEAH H

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

07/12/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,761	Applicant(s) LANGSTROM ET AL.	
	Examiner Leah Schlientz	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Receipt

Applicant's Response, filed 5/17/2010, in reply to the Office Action mailed 12/15/2009, is acknowledged and has been entered. Claims 1-23 are pending, of which claims 10 and 12-23 are withdrawn from consideration at this time as being drawn to a non-elected invention. Claims 1-9 and 11 are readable upon the elected invention and are examined herein on the merits for patentability.

Response to Arguments

Applicant's arguments have been fully considered but are not persuasive for reasons set forth hereinbelow.

Double Patenting

Claims 1-9 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 11/086,632, for reasons set forth in the previous Office Action. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant submits on page 2 of the Response that a terminal disclaimer will be filed once the instant application is in condition for allowance.

However, no terminal disclaimer has been received and the rejection is maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, for reasons set forth in the previous Office Action.

Applicant argues on page 2 of the Response that Figure 1 clearly shows a flow chart of the method according to the invention and that Figures 2 and 3 additionally depict specific views of the present invention.

This is not found to be persuasive. Figures 1-3 provide a general description of the process of preparing labeled compounds including preparing carbon-isotope monoxide enriched gas, providing a high pressure reaction chamber, providing an azide solution to be labeled mixed with a transition metal complex and a liquid reagent, introducing carbon-isotope monoxide enriched gas into a reaction chamber, introducing at high pressure the azide solution mixed with transition metal complex and liquid reagent into the reaction chamber, waiting a predetermined time, and removing the labeled compound from the reaction chamber. However, the figures do not provide description of the identity of liquid reagents and labeled compounds to be produced.

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The specification provides direction regarding the reactions performed between azides and amines, alcohols, thiols, Grignard reagents, unsaturated hydrocarbons, etc. on pages 21-22 of the instant specification, and the production of carbamides, carbamates, thiocarbamates, amides, lactams, oxazolidones, etc. on pages 21-22 of the instant specification. Specific examples of the preparation of diphenylurea, ethylphenylcarbamate, acetanilide, oxazolidone are provided. However, based on such a limited disclosure of a few specific reagents and labeled products which may be produced by the claimed method, a great deal of experimentation would be necessary in order for the skilled artisan to extrapolate the claimed method to include synthesis of any labeled compound using any reagent, based on the almost unlimited number of potential reagents and compounds, and their almost unlimited number and potential orientation of functional groups on such molecules. Accordingly, the claims are more broad than the enabling disclosure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson (*Homogenous Catalysis with Compounds of Rhodium and Iridium*, 1985, Springer. p. 135-137) in view of Kihlberg *et al.* (*J. Org. Chem.*, 2002, 67, p. 3687-92) in

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further view of Kihlberg (WO 02/102711), for reasons set forth in the previous Office Action.

Applicant argues on page 3 of the Response that the prior art itself must provide a motivation or reason for the worker in the art, without the benefit of Applicant's specification, to make necessary changes in the reference device, and that the Office has used Applicant's invention to try to recreate the present invention using Dickson.

This is not found to be persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the Kihlberg references teach the desirability of labeled carbamoyl products such as ureas as an important target for ^{11}C labeling, and teaches their preparation via ^{11}C carbonylation of amines. Dickson teaches another carbonylation reaction (i.e. of azide) to obtain carbamate or urea compounds. One of ordinary skill in the art could have readily performed reactions known in the art at the time of the invention (e.g. carbonylation of azide, as shown by Dickson) using ^{11}C carbon monoxide to obtain the equivalent desirable labeled urea products.

Conclusion

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is (571)272-9928. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday 9 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

LHS